

## **REMARKS**

Applicant is in receipt of the Office Action mailed July 27, 2006. No claims have been amended, added, or cancelled. Therefore, claims 1-80 remain pending in this case. Reconsideration of the present case is earnestly requested in light of the following remarks.

### **Restriction**

The Office Action asserts that newly submitted claims 77-80 are directed to an invention that is independent from the invention originally claimed. In particular, the Office Action asserts that claims 77-80 are directed to a first and a second user configuring a system over a network, and that claims 1-77 do not claim a “second user”. Applicant respectfully submits that claims 77-80 do not refer to a “second user” and instead recites “second user input” and not input received from a “second user”. Thus, Applicant submits that claims 77-80 do not refer to a “second user” as the Office Action asserts.

Applicant notes that the Office Action also asserts:

Thus, the design and operation of the invention in claims 77-80 is different from and not connected to the invention in claims 1-76 which does not have a second user. Furthermore, the invention of claims 77-80 is not an obvious variation of the invention of claim 1-76 because the “second user” is not required in claims 1-76.

Applicant respectfully submits that even did claims 77-80 require a “second user”, which they currently do not, the claimed inventions are not independent as required by MPEP 806.06. As the Examiner is certainly aware:

Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect. If it can be shown that two or more inventions are independent, and if there would be a serious burden on the examiner if restriction is not required, applicant should be required to restrict the claims presented to one of such independent inventions.

The MPEP goes on to describe examples of independent inventions:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions, and different effects are independent. An article of apparel and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process of any part thereof, they are independent. A specific process of molding is independent from a molding apparatus that cannot be used to practice the specific process.

Applicant submits that the inventions in claims 1-76 and those in 77-80 do not constitute independent inventions as required by the MPEP. In particular, Applicant respectfully submits that the two claim sets are clearly directed towards configuring a system in an e-commerce system by configuring portions of the system by selecting images and choosing options for components of the system. Clearly, these two claim sets relate to inventions which have a “disclosed relationship” and are connected in “design, operation, and effect”. Furthermore, Applicant notes that the Office Action does not provide that there would be a serious burden on the Examiner if the restriction was not required as stipulated by this section of the MPEP. Thus, Applicant submits that even were there two different users in these claims, the Office Action’s reasoning does not yield a sufficient reason for restriction of these claims. Correspondingly, Applicant respectfully requests removal of this improper restriction.

## **Objection**

The Examiner objected to Figures 1 and 5 as not being designated as Prior Art noting that US Patent No. 5,710,727 includes similar Figures 1 and 2.

Applicant respectfully submits that Figures 1 and 5 are not Prior Art for the instant Application. As described in the instant specification, various embodiments may utilize the systems illustrated in Figures 1 and 5. For example, page 7 describes that the e-commerce system illustrated in Figure 1 may be used to carry out various embodiments of the invention. Similarly, Figure 5 illustrates various components and architectures which may be chosen or customized by the user according to embodiments of the invention. Thus, Applicant submits that Figures 1 and 5 are not Prior Art and, in fact,

illustrate a means for some embodiments described in the instant Application. Applicant therefore requests removal of the objections to Figures 1 and 5.

In response to this argument, the instant Office Action asserts: “furthermore, in the parent application (US 6,985,876) the same Figures 1 and 5 were designated as prior art”. Applicant respectfully submits that simply because the Figures have been designated prior art in a previous case does not constitute sufficient reasoning for doing so in the present Application. More specifically, as stated above, these Figures illustrate systems which carry out various embodiments described in the instant Application and are therefore not prior art as the Office Action asserts. Removal of the objection is therefore requested.

### **Section 103 Rejection**

The Office Action rejected claims 1-76 under 35 U.S.C. § 103(a) as being unpatentable over Henson (US 6,167,383, “Henson”) in view of IBM Technical Disclosure Bulletin (“IBM”) and in view of Motomiya (US 6,083,267, “Motomiya”).

Regarding claim 1, Henson in view of IBM and Motomiya fails to teach or suggest **providing an image of the system to the client system via the network for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system and receiving user input via the network selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration.** The instant Office Action admits that Henson fails to disclose these features of claim 1, and relies on IBM, stating:

However, IBM discloses a method of configuring a system that provides an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system.

Applicant reminds the Examiner that the Visual Configurator (VC) taught by IBM specifically resides on a single computer, and thus teaches away from this feature of claim 1. More specifically, IBM discloses that the VC is an improvement over the

existing text-based configurator, which “is used by sales reps to select the correct set of feature codes to represent a specific machine configuration” (Page 370, lines 5-6). Additionally, IBM discloses, “the Visual Configurator runs on a DOS-based PC system” (Page 370, line 23); in other words, the VC clearly runs on *a single machine*. Applicant respectfully submits that those skilled in the art of e-commerce understand that a program executing independently on a single computer cannot teach an e-commerce system, much less *providing an image of the system to the client system via the network for display*.

Applicant notes that the Office Action admits that “the cited prior art does not teach that the image is provided to the client system via a network, or that the user selects an image via a network” and relies on Motomiya to teach this feature of claim 1. However, Applicant respectfully submits that this combination is improper. More specifically, per *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992): The combination of elements from non-analogous sources, in a manner that reconstructs the Applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Applicant's invention itself. Additionally, per *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant notes that Motomiya teaches a method for designing jewelry, such as a necklace or a bracelet. Motomiya teaches display of a multiplicity of photographic images of various jewelry components, from which the user may select desired jewelry components to design a necklace or bracelet.

In addition, Motomiya in column 3, line 65 through column 4, line 4 teaches system with:

a multitude of photographic images of the various parts making up the accessory constituting the particular commodity to enable the customer to design it by himself/herself.

In column 4, lines 30-44, Motomiya teaches that:

the material, the color and the length of the equipment, the color of the fasteners and the color of the beads are presented for selection as parts required for designing the necklace or the bracelet.

In other words, Motomiya teaches selection of accessories for a jewelry item being designed such as a bracelet or necklace.

Thus, Applicant respectfully submits that the jewelry design taught in Motomiya is significantly different from *configuring a computer system* as taught by Henson and IBM, and is therefore non-analogous. Additionally, Applicant submits that one skilled in the art would not consider Motomiya as relevant to the systems presented in the instant Application. Applicant reminds the Examiner that the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. Correspondingly, Applicant submits that, as stated above, the combination of Henson and IBM with Motomiya is improper.

Applicant notes that the Office Action also asserts:

Furthermore, it well within the level of one of ordinary skill in the art to port a DOS based application to any other platform such as the Internet....Hwang discloses that it is well known in the art to port a DOS-based application to a windows environment in order to take advantage of more powerful equipment. Marks on the other hand, discloses that it is well known in the art to port a Windows application to the World Wide Web in order to take advantage of the Internet. Thus, the Examiner strongly disagrees with the Applicant's argument that the Visual Configurator of IBM teaches away from the feature of claim 1 since porting an application from one environment to another environment is an obvious modification.

Applicant respectfully disagrees that the two cited references, Hwang and Marks, render obvious porting any DOS application ever made to an Internet program. More specifically, Applicant submits that these two references do not at all indicate that the DOS application taught by IBM could somehow be transformed into the specific e-commerce system recited in the claims with or without the other cited references. For example, Hwang discloses a development tool for allowing programmers to recompile DOS applications "for Windows support with few changes". Applicant respectfully submits simply because a DOS based application could possibly have been ported to

Windows does not indicate the desirability to do so or render the specific process obvious. Additionally, as those skilled in the art understand, such porting Applications are not guaranteed to work for every program. Applicant notes that the Office Action emphasizes that PenRight Pro will include features that will support wide-area wireless communications. However, simply because the development tool supports this feature, does not indicate any desirability (or render obvious) adding such capabilities to the DOS based application. Porting a DOS application to Windows does not change the fact that the application is specifically designed for running on a single machine as disclosed by IBM.

Marks discloses that Gary Fielland started a new company that allows Windows applications to be ported to the World Wide Web using Microsoft's ActiveX technology. Applicant respectfully submits that simply because a company was started that converts some applications from Windows to the World Wide Web does not mean that the process is obvious. Clearly, a great deal of work is required as that is the company's intended mode of operation. Additionally, conversion of a Windows Application to an Internet application does not somehow transform the application into the e-commerce system recited in the claims. If the arguments presented in the instant Office Action were followed to their logical conclusion, conversion of **any** DOS based application to an Internet application would be obvious. Applicant respectfully submits that, as one skilled in the art understands, this is clearly not the case. Thus, Applicant disputes the Office Action's assertion and resubmits that IBM specifically teaches a DOS based application which teaches away from the e-commerce system recited in claim 1. Additionally, it would not be obvious to modify the visual configurator (with or without the cited references) to an Internet Application which performs the functionality of the features of claim 1.

Furthermore, Applicant submits that there is no suggestion to combine Henson, IBM, and Motomiya. In the instant Office Action, regarding the combination of Henson and IBM, the Examiner stated:

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Henson. One of ordinary skill in the art would have been motivated to do so in

order to provide a "...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..." as taught by IBM. [Sic]

Applicant respectfully submits that the Examiner's provided motivation simply points out a feature of the invention disclosed in IBM; moreover, the Examiner fails to provide any suggestion whatsoever from IBM or Henson to combine the two inventions. Applicant reminds the Examiner that, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "**must be clear and particular . . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'.**" *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. **That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.**

Applicant submits that the Examiner's provided suggestion to combine merely points out a presumed benefit of the combination of Henson with IBM and does not indicate any suggestion by the references to make the proposed combination. Moreover, Applicant respectfully submits that Henson nowhere suggests any motivation to make the combination proposed by the Examiner; similarly, IBM fails to indicate any suggestion for combination with Henson. Finally, as also argued above, IBM fails to disclose an e-commerce system or indicate the desirability of incorporating the *stand-alone* VC into a *networked system* such as the Internet. Regarding the combination of Henson and/or IBM with Motomiya, as argued above, Motomiya is clearly non-analogous with the computer systems of Henson and IBM as well as the systems presented in the instant Application.

Additionally, neither Henson, IBM, nor Motomiya provides a motivation to combine Motomiya into Henson and/or IBM. In fact, the only suggestion of motivation to combine asserted by the Examiner is "to provide the customer with a display of the

product as it was being configured”, thus simply citing an improved result based on hindsight analysis of Applicant’s system as claimed. Thus, for at least the reasons provided above, **the rejection is improper.**

Thus, even were the references combinable, which Applicant argues they are not, as argued above, Henson, IBM, and Motomiya, taken singly, or in combination, fails to disclose all of the features and limitations of claim 1, and so Applicant submits that claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over the cited art, and are thus allowable.

Claims 17, 33, 49, 50, 51, 52, 62, 69, 76, and 77 include similar limitations as claim 1, and so the above arguments apply with equal force to these claims. Additionally, Applicant submits that claims 17, 33, 50, 51, 62, 69, 76 are specifically directed towards measurement systems, computer systems, or electronic systems, with which Motomiya is clearly non-analogous. Thus, for at least the reasons provided above, Applicant submits that claims 17, 33, 49, 50, 51, 52, 62, 69, 76, and 77, and those claims respectively dependent therefrom, are patentably distinct and non-obvious, and are thus allowable.

Regarding claim 17, Applicant submits that Henson in view of IBM fails to teach or suggest **receiving a request from a user of the client system via the network to configure the measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device.** With regard to this feature, the Examiner admits that the cited art fails to disclose measurement systems, and states:

However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore, this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what system was displayed on the computer screen. The differences between the content of what is displayed on the computer screen of the Applicant’s invention and the prior art are merely subjective. Thus, this nonfunctional descriptive material will not distinguish the claimed invention



from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106.

Applicant respectfully submits that the Examiner has mischaracterized the claims as presented in the instant Application; each instance regarding measurement systems is a **positive limitation** on the claim and is not nonfunctional descriptive matter. Applicant reminds the Examiner that the MPEP is clear on its description of nonfunctional descriptive matter. For example, the MPEP refers to various nonfunctional descriptive matters such as “music, literature, art, photographs and mere arrangements or compilations of facts or data”. Applicant respectfully submits that a measurement system clearly does not fall into this category, and that claim 17, as recited, defines a functional interrelationship between the measurement system and the method described. For example, in the feature of claim 17 recited above, a request is received from a user **to configure the measurement system**. Additionally, **the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device**. Thus, Applicant submits that the claim defines a functional interrelationship with the way in which the method is performed, e.g., that a user may configure the measurement system, the measurement system includes one or more customizable components, and at least one of the components is a measurement device, among others. Moreover, Applicant submits that the numerous features regarding the measurement system are positive limitations on the claim and are not nonfunctional descriptive matter.

Furthermore, even were the claim limitations regarding the measurement system nonfunctional descriptive matter, which Applicant argues they are not, **the rejection would still be improper**. In the instant Office Action, the Examiner states that the nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability citing MPEP 2106, *In re Gulak* and *In re Lowry*. Applicant respectfully submits that the cited section of the MPEP and the cited cases do not support the reasons for rejection given by the Examiner. For example, MPEP 2106 is specifically directed towards the claiming of non-statutory matter. In other words, 2106 of the MPEP states that claims which solely include nonfunctional descriptive matter

such as literature, art, or other media should be rejected under 35 U.S.C. § 101; it nowhere states that nonfunctional descriptive matter cannot distinguish the claimed invention from the prior art as asserted by the Examiner. Additionally, Applicant notes that the two decisions, *In re Gulak* and *In re Lowry*, actually refer to the patentability of printed matter and are not pertinent to the issue at hand. Thus, for at least the reasons provided above, even were the claim limitations regarding the measurement system nonfunctional descriptive matter, which Applicant argues they are not, the rejection would still be improper.

Additionally, Applicant notes that the Examiner asserts, “the difference between the content of what is displayed on the computer screen of the Applicant’s invention and the prior art are merely subjective”. Applicant respectfully disagrees and submits one skilled in the art understands that measurement systems are not the same as the computer systems described in Henson and IBM. Applicant submits that the Examiner has not provided reasons as to why the differences stated above are merely subjective. Accordingly, pursuant to M.P.E.P. § 2144.03 Applicant submits that “the Examiner must provide documentary in the next Office action if the rejection is to be maintained”. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Furthermore, Applicant reminds the Examiner that according to the MPEP 2143.04 “ ‘All words in a claim must be considered in judging the patentability of that claim against the prior art’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496”. As a specific example from the recited limitation above, the Examiner does not address *wherein at least one of the customizable components is a measurement device* in the instant Office Action. The Examiner implies that this limitation is rejected because “what is displayed on the computer screen does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention”. Accordingly, Applicant respectfully submits that, as one specific example, *wherein at least one of the customizable components is a measurement device* is a real limitation on what is displayed and configured in the method of claim 17 and is not a subjective interpretation of information.

Applicant further submits that the above arguments apply with equal force to the following limitations of claim 17:

providing an image of **the measurement system** to the client system via the network for display, wherein images of at least a subset of the one or more customizable components form at least a portion of **the image of the measurement system**;

determining customizable component selections for at least one of the one or more customizable components of **the measurement system** in response to user input, wherein said determining customizable component selections comprises:

receiving user input selecting an image of a first customizable component via the network which is visually depicted in the image of **the measurement system**, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration; and

receiving user input selecting a first customizable component option for the first customizable component via the network, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component;

wherein the customizable component selections applied to the measurement system **specify a configured measurement system**.

With respect to this argument, the instant Office Action asserts, “the Examiner respectfully disagrees because the ‘measurement system’ does not play any part in the claims whatsoever. Applicant respectfully submits that this statement fails to address any of the arguments presented above. As stated above, each recitation related to the measurement system **provides a positive limitation on the claim**; the Examiner must **consider all words in a claim in judging patentability of a claim with regard to the prior art**; non-functional descriptive matter (or the cases and sections of the MPEP cited by the Examiner) **has nothing to do whatsoever with the measurement system recitations in the claims** nor can it justify the rejection of the claims; the Examiner **has not provided** “documentary in the next Office action if the rejection is to be maintained” pursuant to M.P.E.P. § 2144.03; and the Examiner has **not provided any evidence** that the difference between the content of the display of the Applicant’s invention and the prior art is merely subjective.

Finally, as indicated above, Applicant submits that claim 17 includes similar limitations as claim 1, and so the arguments above regarding claim 1 apply with equal force to this claim. Thus, for at least the reasons provided above, Henson, IBM, and Motomiya, taken singly, or in combination, fails to teach or suggest all of the features and

limitations of claim 17, and so Applicant submits that claim 17 and those claims dependent therefrom are patentably distinct and non-obvious over the cited art, and are thus allowable.

Claim 51 includes similar limitations as claim 17, and so the above arguments apply with equal force to these claims. Thus, for at least the reasons provided above, Applicant submits that claim 51, and those claims respectively dependent therefrom, are patentably distinct and non-obvious, and are thus allowable.

With regard to claim 2, Applicant respectfully submits that Henson in view of IBM and Motomiya fails to teach or suggest **providing an image of the configured system via the network to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user**. The Examiner admits that Henson in view of IBM fails to teach this feature of claim 2, but erroneously asserts that Motomiya provides this missing feature, and further asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Motomiya into the method and system of Henson, and that such a combination produces Applicant's invention as represented in claim 2. Applicant respectfully submits that Motomiya, like Henson and IBM, fails to teach this feature of claim 2. As argued above, the Motomiya is clearly directed towards a non-analogous method for designing jewelry, and not the computer systems described in Henson and IBM or the systems described in the instant Application. Thus, for at least the reasons provided above, Applicant respectfully submits that Henson and Motomiya, taken individually or in combination, fail to teach or suggest every element of Applicant's claim 2.

Moreover, neither Henson, IBM, nor Motomiya provides a motivation to combine. In fact, the only suggestion of motivation to combine asserted by the Examiner is "to provide the customer with a display of the final configured product before the customer placed an order for the product", thus simply citing an improved result based on hindsight analysis of Applicant's system as claimed.

Thus, for at least the reasons provided above, Applicant submits that Henson in view of IBM and Motomiya, taken singly or in combination, fails to teach all the features and

limitations of claim 2, and so Applicant submits that claim 2 and those claims dependent therefrom are patentably distinct and non-obvious over the cited art, and are thus allowable.

Additionally, claims 18, 34, 56, 66, and 73 include similar limitations as claim 2, and so the above arguments apply with equal force to this claim. Additionally, Applicant submits that these claims are specifically directed towards measurement systems and computer systems, with which Motomiya is clearly nonanalogous. Thus, for at least the reasons provided above, Applicant submits that claims 18, 34, 66, and 73, and those claims dependent therefrom, are patentably distinct and non-obvious, and are thus allowable.

Applicant also submits that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## **CONCLUSION**

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above-referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Meyertons, Hood, Kivlin, Kowert & Goetzel P.C., Deposit Account No. 50-1505/5150-40801/JCH.

Respectfully submitted,

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